

Application No. 10/660,063
Amendment and Response to the Office Action Dated February 23, 2007
Docket GB920020082US1

REMARKS/ARGUMENTS

Claims 1-31 are pending in this application. Claims 1, 15, and 29-31 are independent. Claim 29 has been amended.

Claim Rejection - 35 U.S.C. § 101

The Patent Office rejected claim 29 under 35 U.S.C. § 101 as lacking patentable utility. Applicant respectfully traverses the rejection. The Patent Office stated that one of ordinary skill in the art would not read into the limitations of the claim hardware that would enable claim 29 to perform the steps recited. Applicant respectfully disagrees. Amended claim 29 is directed to a computer readable set of instructions. Computers are only able to read instructions that are embodied on media readable by the computer. By the very definition of the words, a computer readable set of instructions must be embodied on a computer readable medium or other hardware and be executable by a processor or processing device. Thus, amended claim 29 has patentable utility and is directed to statutory subject matter under 35 U.S.C. § 101. Amended claim 29 is allowable and withdrawal of the rejection of claim 29 is requested.

Claim Rejection - 35 U.S.C. § 112

The Patent Office rejected claim 29 under 35 U.S.C. § 112 ¶ 1 as not being supported by either a credible asserted utility or a well established utility for the reasons set forth above. Applicant respectfully traverses. However, claim 29 has been amended and is now allowable.

Claims Rejections - 35 U.S.C. § 103(a)

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The Patent Office rejected claims 1-3, 7, 8, 13, 15-17, 21, 22, 27, and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Okada et al. (U.S. Patent No. 7,099,867) ("Okada") in view of Mandato et al. (U.S. Patent Publication No. 20010025280) ("Mandato"). Applicant respectfully traverses.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicant respectfully submits claims 1, 15, and 29-31 recite elements not disclosed, taught or suggested by any of the references cited by the Patent Office, either alone or in combination. For example, claims 1, 15, and 29-31 generally recite means, responsive to analysis of the text, for modifying said text to create a second message in order to add context thereto. The Patent Office cited to Okada, column 7, lines 32-41, as disclosing the above elements. However, Okada does not recite means creating a second message with context added. Rather, the portion of Okada cited by the Patent Office recites:

"For example, if a keyword having a degree of importance in a range of from "16" to "20" occurs in a speech from other client machine, the keyword is displayed in red in an IRC window, and, at the same time, a big is generated. Alternatively, the keyword may be pronounced, using a synthetic voice. If a keyword having a degree of importance in a range of from "11" to "15" occurs in a speech from other client, it may be displayed in green in the IRC window, and a beep of a moderate

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magnitude or a synthetic voice representing the keyword may be generated."

(Okada, Column 7, Lines 32-41). Okada discloses a method for disclosing degrees of importance of keywords and not means creating a second message with context added. Mandato fails to cure the defects of Okada. Mandato discloses a method for conveniently managing user profile information in a unified instant messaging system. (Mandato, Abstract). For at least the above reasons, claims 1, 15, and 29-31 are allowable.

Additionally, there is no suggestion in any of the references that they be combined in the manner suggested by the Patent Office. There is no suggestion in the related art to combine the references in the manner suggested by the Patent Office. Absent such a suggestion, a person skilled in the art developing an efficient method and way to add context to a chat transcript would hardly be disposed on any objective basis to consider references like Okada and Mandato. Okada and Mandato show no recognition of adding context to a chat transcript let alone any other solution that would avoid or solve it.

Further, Okada and Mandato are complete and functional as individual references, and there would be no reason to use parts from or add or substitute parts to any reference. Okada teaches determining key words and determining the degree of importance of the keyword. (Okada, Abstract). Mandato teaches a method for conveniently managing user profile information in a unified instant messaging system. (Mandato, Abstract). The combined references do not teach adding context to a chat transcript. Each reference stands independent of the others and no motivation exists to combine parts from any reference.

Therefore, claims 1, 15 and 29-31 are patentably distinct from the combination of Okada in view of Mandato, and independent claims 1, 15 and

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29-31 are nonobvious under 35 U.S.C. § 103(a). Independent claims 1, 15, and 29-31 are allowable based on the reasons discussed in the previous paragraphs. Claims 2-3, 7, 8, 13, 16-17, 21, 22, and 27 depend on independent claims 1, 15, and 29-31, which are allowable based on at least the rationale discussed in the previous paragraphs. Thus, dependent claims 2-3, 7, 8, 13, 16-17, 21, 22, and 27 are allowable based upon their dependence on allowable base claims.

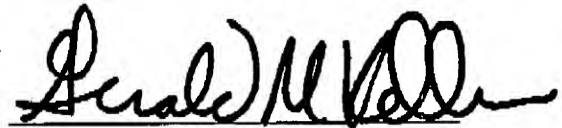
CONCLUSION

In light of the forgoing amendments and arguments, reconsideration of the claims is hereby requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted, on behalf of,
IBM Corporation

Dated: August 27, 2007

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